

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte LANCE P. KELSON  
and ROSS J. KELSON

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Appeal No. 98-0177  
Application 08/577,873<sup>1</sup>

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ON BRIEF

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Before CALVERT, COHEN, and PATE, Administrative Patent Judges.

PATE, Administrative Patent Judge.

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<sup>1</sup> Application for patent filed December 22, 1995.  
According to applicants, the application is a continuation-in-  
part of Application 07/901,922, filed June 22, 1992, now  
Patent No. 5,531,323, issued July 2, 1996.

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DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 4 and 5. The only other remaining claim in the application, claim 3, has been indicated as directed to allowable subject matter.

The claimed invention is directed to a device for the removal and disposal of a needle assembly from the barrel sleeve of the trademarked VACUUTAINER blood sampling apparatus.

Claim 1 reproduced below is further illustrative of the claimed subject matter:<sup>2</sup>

1. A device for removal and disposal of a needle assembly with a hub threadably engaging a threaded nipple of a barrel sleeve of a body fluid specimen sampling assembly, said hub having a lowermost portion comprising at least one flute outstanding in a plane radial and longitudinal to the needle of said needle assembly, said device comprising:

a disposal container closed by a lid upwardly thereon,

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<sup>2</sup>In subparagraph 5 of claim 1, we note that the hub wrenching member is described as extending substantially horizontally partially across the perforation. With reference to Figure 28, we note that the hub wrenching member 86 with slot 85 extends across the perforation at an acute angle from the horizontal. Therefore, we deem subparagraph 5 of claim 1 to be misdescriptive of the orientation of the wrench member. The language of the claims should be corrected in any further prosecution before the examiner.

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the lid comprising

a plate member covering an opening in the disposal container,

a perforation through the plate member,

a hub wrenching member carried by the plate member extending substantially horizontally partially across the perforation positioned to engage the radially extending side of the flute of the needle assembly when placed downwardly thereinto, so that said needle assembly may be removed from the barrel sleeve by rotation of said sleeve; and

means carried by the lid for supporting the barrel sleeve vertically aligned with the lid perforation and the flute engaging wrenching member.

The following reference is cited by the examiner as evidence of anticipation:

Thead et al. (Thead)	4,986,811	Jan. 22, 1991
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REJECTIONS

Claims 1, 2, 4 and 5 stand rejected under 35 U.S.C. § 102(b) as anticipated by Thead. According to the examiner, Thead discloses a device for the removal of a needle comprising a container 12, a plate member 29, means 31 for supporting the barrel sleeve, and a hub wrenching member gears 61, 62. These gears, according to the examiner, define a forked member.

Claims 1, 2, 4 and 5 stand rejected under the judicially-

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created doctrine of obviousness double patenting over claim 4 of U.S. Patent No. 5,531,323.

With respect to the anticipation rejection, appellants argue that Thead has no hub wrenching member as defined in claim 1. Appellants state that this feature alone prevents Thead from anticipating appellants' claim. Furthermore, appellants argue that it is impossible for a user to remove Thead's needle by rotating the barrel alone. According to appellants, the gears of Thead must be rotated for the needle to drop into the container. See appellants' brief at page 6 for the details of these arguments. Attention is also directed to page 2 of the reply brief where appellants reiterate the impossibility argument.

#### OPINION

We have carefully reviewed the rejections on appeal in light of the arguments made by the examiner and the appellants. As a result of this review, we have determined that the applied prior art patent to Thead anticipates appellants' claims. Furthermore, we have determined that appellants do not contest the double patenting rejection. Therefore, the rejections of the claims on appeal will be

affirmed.

Turning first to the double patenting rejection, appellants do not argue this rejection. Accordingly, the rejection of claims 1, 2, 4 and 5 under the judicially created doctrine of obviousness double patenting is summarily affirmed.

Turning to the anticipation rejection of claims 1, 2, 4 and 5, we are in agreement with the examiner that Thead discloses a disposable container 12, a plate 29 covering an opening in the disposal container, a perforation 33 through the plate member and a hub wrenching member comprising gears 60 and 61. We further note that supported by plate 29 of the lid is a means 31 for supporting the barrel vertically aligned with the perforation. In our view, the means 31 of Thead -- an upstanding cylindrical barrel -- is the same means disclosed in appellants' specification for providing the function of supporting the barrel sleeve in appellants' claimed invention.

Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention.

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See In re Paulsen, 30 F.3d 1475, 1480-81, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994). It does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference.

See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). It also does not require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in

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the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

As noted above, the Thead reference includes each and every element of the claimed invention. Therefore, we agree with the examiner's finding that Thead anticipates appellants' claim.

Appellants argue that Thead does not disclose a hub wrenching member that extends substantially horizontally partially across the perforation. We disagree. Thead clearly discloses gear means 60 and 61 which extend partially across the perforation 33 in a horizontal direction to engage the hub of the needle. Appellants further argue that it is impossible for the needle to drop into the container if the gears are stationary and the barrel is disengaged by rotation of the barrel alone. We note that appellants have not provided any evidence that such is the case, but only provide attorney argument that this is so. We make no finding as to whether the needle will drop if the barrel is rotated while the gears remain stationary. We do not find that the claims require that the needle drop into the container. In fact, the hub



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wrenching member is described in mere functional language as operating "so that the needle assembly may be removed from the barrel sleeve by rotation of said sleeve." Thus, claim 1 does not require the removed needle to drop into the container. Therefore, even if the functional language of claim 1 is given weight, it does not require the function that appellants have premised their impossibility argument upon. And, it is again noted that appellants have provided no evidence of the alleged impossibility.

SUMMARY

For the foregoing reasons, the rejections of claims 1, 2, 4 and 5 under 35 U.S.C. § 102(b) and the judicially-created doctrine of obviousness double patenting are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT

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IRWIN CHARLES COHEN	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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WILLIAM F. PATE, III	)	
Administrative Patent Judge	)	

WFP:svt

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